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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,394	08/15/2000	Keith Benson	PM 268484	1984

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EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/638,394

Applicant(s)

BENSON, KEITH

Examiner

Jack Chiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **CLAIMS**

### **Double Patenting Rejection**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 8-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No.

6,292,561. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the present claimed limitations, such as the identification modules or first and second networks, the switch means, the holder, are all substantially claimed in the above patent.

### **Art Rejection**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8-18, 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohm (WO 89/00370).

Regarding claim 8, Bohm shows a digital phone having at least two subscriber identification modules (A-D in 10) comprising the steps of;

Providing a first network (i.e. A) accessible by the phone;

Providing a second network (i.e. B) accessible by the phone;

Selectively switching (9) between the networks (A, B) by selecting for connection of the phone to the first or second module (A-B), wherein providing the first network comprising providing the first module (A), providing the second network comprising providing the second module (B).

Regarding claim 11, Bohm shows accessing networks by different users (such as a company sharing limited phones, or a family sharing a phone) of a mobile phone having at least two subscriber identification modules (A-D in 10) comprising the steps of;

Providing a first network (i.e. A) accessible by the phone;

Providing a second network (i.e. B) accessible by the phone;

Selectively switching (9) between the networks (A, B) by selecting for connection of the phone to the first or second module (A-B), wherein providing the first network

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comprising providing the first module (A), providing the second network comprising providing the second module (B).

Regarding claim 15, Bohm shows accessing networks by of a mobile phone comprising:

Providing at least two subscriber identification cards (A-D in 10) which are installable and removable by a user (see claim 6), and a switch (9) to select between the cards (A-D) for connection to the phone, the switch including memory and software programming associated with the switch (9, 7), each card (A-D) permitting the phone to access a respective network as a function of the switch (9);

Selecting a network (with A-D) with the switch (9).

Regarding claim 21, Bohm shows a digital phone comprising at least two subscriber identification modules (A-D), and comprising:

At least two subscriber identification modules (A-D), and a switch (9) to select between the cards (A-D) for connection to the phone, each card (A-D) permitting the phone to access a respective network as a function of the switch (9).

Regarding claims 9-10, 12-14, 16-18, 22, Bohm shows:

The electronically switching (7, 9) between the networks (A-D), including operable by logic comprised of the software program in the memory (see 7);

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Activating a switch (abstract, line 6) on the phone to select the networks (A-D);

The phone can be a digital phone (most networks are digital);

The holder (10) is attachable to the phone.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohm in view of Kaneshige et al. (US 5655917).

Regarding claim 19, Bohm shows a digital phone equipped with a holder (10) and capable of using at least two subscriber identification modules (A-D) comprising:

At least two subscriber identification modules (A-D), the holder (10) comprising at least two subscriber identification modules (A-D), and a switch (9) to select between the cards (A-D) for connection to the phone, each card (A-D) permitting the phone to access a respective network as a function of the switch (9).

Bohm differs from the claimed invention in that it does not explicitly mention that the holder detachably connected to the phone.

However, it is commonly seen that card holders are detachably connected to a phone.

This is taught by Kaneshige, such as the detachable card holder (12).

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Hence, if it is found that Bohm's card holder is integrally formed, it would have been obvious for one of ordinary skill in the art to modify Bohm with a detachable holder as taught by Kaneshige by taking the advantage of Kaneshige's holder to prevent a user inadvertently remove the card during the use of the card (col. 1, lines 50-53 in Kaneshige).

Regarding claim 20, the combination of Bohm shows:

The electronically switching (7, 9 in Bohm) between the networks (A-D), including software program in the memory (see 7).

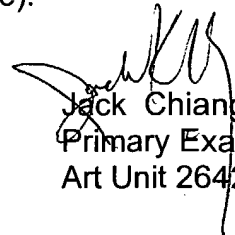
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang  
Primary Examiner  
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